

## RESPONSE

### Claim Rejections under 35 U.S.C. § 112.

Claims 1-7 stand rejected under 35 U.S.C. § 112, second paragraph ("Section 112") as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended claims 1, 2, 5 and 6 as suggested by the Examiner to overcome the former deficiencies. Each amendment finds support in the specification as originally filed and thus adds no new matter.

Applicants respectfully submit that the amendments made to the claim set overcome the rejections made by the Examiner under Section 112, second paragraph. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 1-7 under Section 112, second paragraph.

### Claim Rejections under 35 U.S.C. § 102(e).

Claim 1 stands rejected under 35 U.S.C. § 102(e) ("Section 102(e)") as anticipated by U.S. Pat. No. 6,438,426 to Hofstad ("Hofstad").

An invention is unpatentable under Section 102(e) if "the invention was described in . . . a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." A Section 102(e) rejection is only appropriate, however, where "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). For the reasons set forth below, Applicant submits that the reference cited by the Examiner does not teach each and every element of the claimed invention, as amended, and thus

does not anticipate the present invention.

Applicant's claim 1, as amended, recites "a switch to selectively couple the second end of each electrode either to the defibrillator or to the monitoring device." Applicant finds no mention of this limitation in any cited reference, nor any equivalent thereof.

Rather, Hofstad teaches a coronary sinus catheter that includes a distal electrode portion with optimally-spaced and sized ring electrodes and a proximal electrode portion with at least one optimally-spaced and sized larger surface electrode. See Abstract. Hofstad further discloses a control unit attached to the catheter that includes a "switch [that] permits operating ring electrode pairs independently for cardiac mapping or pacing, or together in series to act as a single electrode for defibrillation/cardioversion." See col. 3, ln. 54-57.

The switch disclosed in Hofstad, however, fails to anticipate the switch claimed by the present application. Indeed, the Hofstad switch controls only the degree of operative connection between multiple independent ring electrodes on a catheter. Depending on the position of the switch, the ring electrodes may operate "independently for cardiac mapping or pacing," or may be "electrically coupled in series to act as one large electrode." See col. 3, ln. 54-55; col. 4, ln. 33-34. Hofstad fails to disclose any switch to selectively couple the catheter or a particular electrode to either a defibrillator or a monitoring device, as claimed by the present application.

As Hofstad fails to teach each and every element as set forth in claim 1 of the present application, Hofstad fails to anticipate the present invention under Section 102(e). Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 1 under Section 102(e).

Claim Rejections under 35 U.S.C. § 103.

Claims 2-5 stand rejected under 35 U.S.C. § 103(a) ("Section 103") as unpatentable over Hofstad.

An invention is unpatentable under Section 103 "if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

To establish a *prima facie* case of obviousness, three criteria must be met. "First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2142.

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be "found in the prior art, and not based on applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991).

A "clear and particular" showing of the suggestion to combine is required to support an obviousness rejection under Section 103. *Id.* For the reasons set forth below, Applicant submits that the prior art fails both to teach or suggest all the claim limitations, and to clearly and particularly suggest the combination indicated by the Examiner; thus, Applicant's claims are not obvious in view of the prior art references.

As discussed above, Applicant's claim 1 recites "a switch to selectively couple the

second end of each electrode either to the defibrillator or to the monitoring device.” As Hofstad fails to disclose or suggest such a switch, Hofstad fails to either anticipate or render obvious the present invention.

Indeed, as discussed above with reference to Section 102(e), the switch disclosed by Hofstad operates solely to control the degree of electrical communication between individual electrodes on a catheter. In this manner, Hofstad requires only one catheter to process information and/or to perform cardioversion/defibrillation. Hofstad, however, neither discloses nor suggests a switch capable of selectively coupling the catheter, or an electrode contained thereon, to either a defibrillator or a monitoring device. Rather, although Hofstad teaches a single catheter capable of performing functions that previously required more than one catheter, Hofstad fails to speak to any novel or innovative way of selectively connecting the single catheter to either a defibrillator or monitoring device. Thus, Hofstad relies on prior art methods of disconnecting and reconnecting the single catheter to a defibrillator or monitoring device as necessary.

As Hofstad neither discloses nor suggests a switch capable of selectively coupling an electrode either to a defibrillator or to a monitoring device, and thus fails to disclose or suggest all of the present claim limitations, Hofstad fails to render obvious the present invention as claimed in claim 1.

As claims 2-5 further depend from otherwise allowable subject matter, such claims are also not rendered obvious by the Hofstad reference.

In light of the foregoing, Applicant respectfully requests withdrawal of the rejections of claims 2-5 under Section 103.

DATED this 29 day of October, 2003.

Respectfully Submitted,

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A handwritten signature in black ink, appearing to read "Michael F. Krieger", is written over the printed name and firm name.

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